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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,276	12/13/2001	Richard Soltys	120109.406	6054
500	7590	07/12/2005	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			NGUYEN, KIM T	
701 FIFTH AVE			ART UNIT	
SUITE 6300			PAPER NUMBER	
SEATTLE, WA 98104-7092			3713	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/017,276

Applicant(s)

SOLTYS ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005 and 29 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-37,41-49 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-26,28-37,41-49 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of the RCE on 4/22/05 filed with the amendment on 12/29/04. According to the amendment, claims 1-7, 9-37, 41-49 and 57 are pending in the application.

Duplicated claims

1. Applicant is advised that should claim 47 be found allowable, claim 48 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 9-37, 41-49 and 57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, 7, 9-11, 13-15, 17-19, 35 and 39-40 of U.S. Patent No. 6,638,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7, 9-37, 41-49 and 57 disclose the same subject matter as taught in claims 1-2, 5, 7, 9-11, 13-15, 17-19, 35 and 39-40 of U.S. Patent No. 6,638,161 in broader scope by eliminating reading identifier from each of cards, determining an expected set of playing card values, etc. Further, generating card sequence before printing a first card would have been both obvious and design choice.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7, 9, 12, 16, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation "entire pseudo-random playing card sequence" is not disclosed in the specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-7, 9-26, 28-37, 41-49 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamle (US Patent No. 5,199,710).**

As per claim 1, Lamle discloses a method of distributing playing cards comprising generating a pseudo-random playing card sequence and printing the playing cards having markings according to the pseudo-random sequence (col. 2, lines 1-10). Lamle does not explicitly disclose generating playing card sequence before printing the first card in the sequence, and printing the playing cards in an order matching. However, since Lamle discloses randomly generating signals representing indicia representing card values and feeding the signals to the printing means for printing card values successively using

the generated signals (col. 3, lines 64-67 and col. 4, lines 1-2), Lamle obviously implies teaching generating a sequence of card signals before printing a first card in the sequence. Further, Lamle discloses printing the playing cards corresponding to the successively generating signals representing indicia to be printed (col. 2, lines 1-10). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to generate printing signals in an order matching in order to control the printer of Lamle to print indicia in a selected order.

As per claim 2, Lamle discloses executing the random number generation algorithm on a processor (col. 3, lines 15-20).

As per claim 3-4, Lamle discloses removing an ordered stack of the playing cards one by one from a card shoe (col. 3, lines 8-9; and col. 2, lines 19-21).

As per claim 5-6, Lamle discloses printing playing cards on opposite faces of the card stock (col. 3, lines 52-56). Further, printing playing cards in a selected orientation would have been obvious design choice.

As per claim 7 and 9-10, refer to discussion in claim 1 above. Further, since Lamle discloses printing the cards using the signals indicating indicia of card values, Lamle obviously discloses printing marking on the cards after the generation of the pseudo-random indicia sequence. Further, determining a

portion of entire pseudo-random indicia sequence to be generated would have been both obvious and design choice according to a designer's preference.

As per claim 11 and 57, Lamle discloses activating portions of the playing cards (col. 3, lines 23-31). Further, as to claim 57, applying a charge for producing a playing card would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 12, refer to discussion in claim 7 above. Further, Lamle discloses generating and printing successively sets of playing card value (col. 3, lines 13-31).

As per claim 13, Lamle discloses distributing the playing cards (col. 2, lines 9-10).

As per claim 14, refer to discussion in claim 1 above.

As per claim 15, Lamle discloses a printer for printing playing cards (col. 3, lines 53-56). Further, including a print head and a print head controller in a printer would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 16, refer to discussion in claim 7 above.

As per claim 17, connecting a printer to a host network computer to communicate data between the computers would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 18, Lamle discloses generating print data and transmitting print data to the printer (col. 3, lines 13-20; col. 2, lines 1-10; and col. 3, lines 35-39).

As per claim 19, refer to discussion in claim 7 above.

As per claim 20, dealing playing cards according to a pseudo-random sequence would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 21-22, refer to discussion in claims 5-6 above.

As per claim 23-24, Lamle discloses printing the number of playing cards according to a predetermined number of cards (col. 3, lines 20-23). Further, selecting the predetermined number of cards for printing that is less than 52 would have been an obvious design choice.

As per claim 25, refer to discussion in claim 1 above.

As per claim 26 and 28, storing the printed playing cards in a card shoe and printing a rank and a suit on the playing card would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 29, refer to discussion in claim 12 above.

As per claim 30-31, Lamle discloses including playing card values corresponding to a deck of cards (col. 1, lines 52-53; and col. 3, lines 20-23). Further, including 52 cards in a deck would have been well known.

As per claim 32-33, refer to discussion in claims 2 and 15 above.

As per claim 34-35, Lamle discloses providing different pseudo-random sequence (col. 3, lines 13-30 and 35-37). Further, coupling the printer to a remote processor would have been well known.

As per claim 36-37, reading the card markings would have been well known.

As per claim 41, refer to discussion in claims 1, 32 and 35 above.

As per claim 42-43, Lamle discloses a chip tray and a betting station (Fig. 1; and col. 2, lines 66-68; col. 3, lines 1-2). Further, tracking wagers and value of chips in the chip tray on a gaming table would have been well known.

As per claim 44, refer to discussion in claims 42-43 above.

As per claim 45, reading markings on the discarded cards would have been well known.

As per claim 46-49, refer to discussion in claims 1, 5, and 12 above.

Allowable Subject Matter

7. Claim 27 would be allowable if a terminal disclaimer in compliance with 37 CFR 1.321(c) is filed to overcome the double patenting rejection(s), set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter:

Prior arts of record does not disclose a method for generating a playing

card deck for a card game set forth in claim 25 in which the printed playing cards are stored in a card shoe, and further comprises determining when the number of the printed playing cards in a card shoe falls below a threshold value, and printing markings on an additional number of playing cards in response to the number of printed playing cards in the card shoe falling below the threshold value.

Response to Arguments

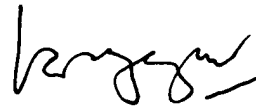
9. Applicant's arguments filed 12/29/04 have been fully considered but they are not persuasive.

In response to applicant's argument in page 17, third paragraph, in col. 3, lines 64-67 and col. 4, lines 1-2, Lamle discloses the two steps: randomly generating signals representing indicia representing card values and then feeding the signals to the printing means for printing card values successively using the generated signals, Lamle obviously implies teaching after generating a sequence of card signals, then printing a first card in the sequence.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 703-872-9306.

kn
Date: June 30, 2005



Kim Nguyen
Primary Examiner
Art Unit 3713